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EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/759,721

Applicant(s)

KIM, YEONG-TAEG

Examiner

Scott Beliveau

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Miscellaneous***

1. Please note that the examination art unit for this application has changed from 2614 to 2623.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 December 2005 has been entered.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-15, 28, and 29 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's argument such that the Butler et al. reference fails to provide a combined digital signal, the examiner respectfully disagrees. Butler et al. explicitly discloses that "... In the case of digital satellite transmission ancillary data can be easily transmitted in digital form along with video and audio ... Protocols such as MPEG-2 already provides for incorporating ancillary digital data in packets that are downloaded with digital audio/video content using satellite transmission facilities ... " (Para. [0015]). The particular

distribution of the video programming along with ancillary digital data is considered to meet the particular recitation of a “combined digital signal”.

With respect to applicant’s arguments such that the “Banner Information” of the instant application is different from that of Butler et al., the examiner respectfully disagrees. The instant application as originally filled clearly sets forth that “Banner Information” is defined as contents in the form text, graphics, images, or any other type of audio visual information which is intended for commercial advertisement and can be presented to the user with any other type of digital television presentation (IA: Page 16, Line 14-16). Butler et al. sets forth that “hyperlink overlays” are similar to documents or web pages [Para. 0022] that can be utilized for advertisements (Para. [0004] and [0046]) and can be displayed non-transparently to overlay the displayed video (Para. [0044]). The particularly argued two-step process does not mean that the particularly displayed overlay of Butler et al. is not contents in the form of text, graphics, images, or any other type of audio/visual information which is intended for commercial advertisement and can be presented to the user with any other type of digital information. “Banner Information” as defined within the specification is not limited to whether or not the overlays are rendered either in the foreground or the background of the video images. Accordingly, applicant’s arguments pertaining to Butler et al. failing to disclose “Banner Information” are not deemed persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Butler et al. provides for the distribution of enhanced content with broadcast video. Watts et al. similarly provides for providing enhanced content with broadcast video, but it also provides the user with the flexibility to turn off the supplemental content. Accordingly, it is the examiner's position that sufficient motivation has been provided by the references themselves.

With respect to applicant's arguments such that the Butler specifically teaches away from the present invention as well as the Watts et al. system because it provides a solution which utilizes conventional formats, the examiner respectfully disagrees. Butler explicitly discloses that the invention may utilize any form of broadcast source (ex. analog, digital, uni-directional, bi-directional, terrestrial, satellite, etc.) (Para. [0013] – [0015]) which can include the usage of MPEG-2 distribution. The instant invention is directed towards a digital TV system which utilizes an application of conventional formats namely MPEG-2. Watts et al. similarly discloses that the system may be associated with a wide range of external sources including digital satellite and digital broadcast providers (Col 2, Line 64 – Col 3, Line 5). The exemplary DVB disclosed by Watts et al. as a means for distribution is based on the MPEG-2 standard. Therefore, all of the systems are directed towards digital television distribution and the usage of conventional formats (ex. MPEG). Both Watts et al. and Butler et al. are clearly in the same field of endeavor namely digital television. Given that the Watts et al. distribution of both video programming and supplemental content can come from the same source such as a digital satellite broadcast and Butler et al. discloses the particular

receipt of MPEG in association with digital satellite, why would the combination preclude the usage of a standardized distribution such as MPEG. Furthermore, the referenced “controller 504” is disclosed as being implemented as a broad category of variety of computing devices including conventional desktop computers as well as Internet “appliance” devices (Col 11, Lines 1-14) which in does not preclude its usage in association with the Butler et al. embodiment, nor would the combination of computing logic associated with a computing controller appear to be an unsuitable modification to a computing device such as that provided by Butler et al.

With respect to applicant’s arguments such that modifying Butler to require user permission for showing the hyperlink overlays goes against Butler’s stated purpose of utilizing conventional formats for providing ancillary data, the examiner respectfully disagrees. Similar to the teachings of Watts et al., supplemental information is distributed to the user irrespective of whether or not the user wants it. The teachings of Watts et al. simply gives the user the ability to further turn the displayed information off. Butler et al. is silent with respect to any teachings that would dissuade one from a modification so as to temporarily disable or turn off supplemental content. While the particular model in the instant application might be different such that the user is provided with a reduced subscription fee for watching advertisements, claim 1 is not so limiting. Nor is the particular usage of agreeing to watch advertisements in exchange for a reduced fee considered novel in light of the art already of record (ex. Blahut et al.).

Applicant’s arguments in association with claim 9 appear to recite applicant’s previously addressed arguments.

With respect to applicant's traversal regarding the examiner's position that applicant's did not adequately/timely traverse the OFFICIAL NOTICE as to the existence of service agreements, MPEP 2144.03 is clear with respect to applicant's proper response. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. The Final Rejection clearly articulated that the applicant failed to traverse the existence of the fact noted (as opposed to whether or not it would involve improper hindsight to modify Butler et al. so as to utilize the fact) and as such the rejection relied upon and continues to rely upon applicant's admitted statement. While the examiner does not does not concede to the applicant's position, it is noted that evidence is already of record. For example, applicant's own disclosure provides evidence as to the particular existence of video distribution services wherein viewers are charged monthly service fees (IA: Page 3, Lines 11-18). The disclosed charging of a monthly service charge is considered service agreement that provides for a limitation on the subscription charged to the end user indicative of the monthly service fee. Further evidence supporting the

OFFICIAL NOTICE can be found in the Blahut et al., Neel et al., and Ebisawa references already of record.

With respect to applicant's further arguments regarding claim 12, that the Butler et al. reference fails to enable the simultaneous display of the Banner Information and the regular programming on the presentation unit, the examiner respectfully disagrees. The Butler et al. reference clearly sets forth the particular usage of non-transparent overlays which serve to be simultaneously presented in conjunction with the displayed video (Para. [0043] – [0044]). As to applicant's arguments, such that the receiver [14] of Butler et al. is patentably distinct from the specialized components associated with the receiver of the instant application, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

With respect to applicant's argument that the examiner's conclusion of obviousness in connection with claims 2-8, 13-15, 17-20 is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Butler et al. reference explicitly discloses the usage of MPEG-2. It is the examiner's position that the particular disclosed usage of the MPEG-2 by Butler et al. would lead one to look to the MPEG-2 standard as a means for implementing the Butler et al. system. The instant



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application concedes that MPEG-2 is a well known standard that allows for consistent and uniform digital video signal sampling, coding, transmission and reception throughout the world and is very well known in the art (IA: Page 2, Line 14 – Page 3, Line 2).

Accordingly, one would be motivated to utilize the standard, not only in view of its disclosed usage by Butler, but for the common knowledge purpose of providing consistent and uniform digital video signal sampling, coding, transmission and reception in a manner which is usable throughout the world. The claim requires the particular usage of TS packetization. The specification discloses that the MPEG standard discloses the particulars associated with TS packetization (IA: Page 18, Lines 18-19). The MPEG-2 standard of record discloses further advantages associated with TS packetization including providing the robustness necessary for noisy channel distribution such as those employed by satellite distribution (Introduction – PART 1 Systems). Accordingly, it is the examiner's position that one would have been motivated sufficiently to utilize the teachings of the MPEG-2 standard in association with Butler et al.

In response to applicant's arguments pursuant to claim 2 against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, as noted in the rejection, Butler et al. is silent with respect to particular details associated with implementing an application of the MPEG-2 standard so as to realize the combined distribution of the enhanced content with broadcast video. The MPEG-2 standard as characterized by applicant's is believed to comprise the missing

elements associated with implementing an application for the distribution of programming along with audio/video overlays as a combined stream.

With respect to applicant's arguments regarding the particular usage of an application of the MPEG-2 standard as requiring a substantially undertaking utilizing a number of elements which would not be obvious, the examiner respectfully disagrees. As previously noted applicants disclose that systems designed in accordance with the MPEG-2 standard involving the coding, TS packetizing, multiplexing, and distribution of programs along with audio and video overlays are very well known to the extent that they have proliferated around the world. Accordingly, the particular implementation of applications of these types of systems would appear to be well within the ordinary skill in the art and that one would be motivated to utilize such systems for the common knowledge purpose of providing consistent and uniform digital video signal sampling, coding, transmission and reception in a manner which is usable throughout the world. The particular argument refuting the case of obviousness based upon the difficulty associated with implementing such a system is lacking an evidentiary showing that the particular implementation of the teachings of the MPEG-2 standard as characterized in applicant's disclosure in light of the disclosed usage of MPEG-2 by Butler et al. would not have been feasible, nor is the examiner aware as to why simply being "difficult" would rebut a prima facie case of obviousness. The worldwide proliferation and implementation and very well known implementation of MPEG-2 distribution systems as noted by applicant's would suggest that it is within the ordinary skill in the art to implement such a system regardless of its "difficulty". Given the highly predictable nature of the video distribution art and the wide usage of MPEG-2, irrespective of the difficulty, one having

ordinary skill would have had reasonable expectation of success in association with implementing the MPEG-2 standard. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (“An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.”).

Regarding applicant’s further arguments pertaining to claim 3, the applicant argues that the system fails to utilize any “modulation function”. The examiner respectfully disagrees. The reference discloses that the system comprises a digital satellite broadcast system wherein the digital signals are distributed on multiple RF frequencies or channels (Para. [0013]). The distribution of digital satellite signals requires “modulation” in order to distribute them on an RF frequency or carrier channel. “[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. 102, on prima facie obviousness’ under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)). Applicant’s have not met their burden of proof providing an evidentiary showing that the particular distribution of digital satellite broadcast signals on multiple RF frequencies or channels can be performed without modulation. Accordingly, applicant’s arguments are not deemed persuasive; however, further evidence has been provided via the incorporated co-

pending application "Broadcast-Enabled Personal Computer" to particularly illustrate usage of modulation rather than simply relying upon inherency.

With respect to applicant's further arguments regarding claims 4-7, 13, 14, and 17-20, applicant's argue that the tuner [60] and the video subsystem [66] of Butler et al. fail to meet the limitations of a several claimed elements. It is the examiner's position that such elements are required by the receiver so as to process an MPEG-2 encoded TS digital signal. For example, given that the multiplexed signal is RF modulated onto a carrier as distributed over a satellite distribution path, how does the receiver [14] and extract and process the signal without demodulating, demultiplexing/depacketing, and decoding the received signal. Given that the particular processing is performed in conjunction with the formulation of the distributed MPEG-2 encoded TS, it would follow that the reverse process would need to be performed by the receiver in order to render the received content. Applicant's have not met their burden of proof providing an evidentiary showing that the particular utilization of these elements is not necessary in order to reverse the processing performed on the distribution end in order to render the displayed image. Accordingly, applicant's arguments are not deemed persuasive; however, further evidence has been provided via the incorporated co-pending application "Broadcast-Enabled Personal Computer" to particularly illustrate the existence of the aforementioned components rather than simply relying upon inherency.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 9, 12, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler (US Pub No. 2002/0007493 A1) in view of Watts et al. (US Pat No. 6,324,694 B1).

In consideration of claim 1, Figure 1 of the Butler et al. reference illustrates a “digital video service network” [10] comprising a “means for providing a combined digital signal” [12] having “information reflective of a regular program signal” and a “Banner Information signal” or ancillary data in the form of HTML advertisement overlays (Para. [0004], [0015], and [0020]) via a “channel communicating the combined digital signal from the means for providing a combined digital signal to the receiver” (Para. [0013]). The aforementioned, “combined digital signal” is subsequently “received” via a “receiver” with an associated “presentation unit” or display [68] which “presents . . . the Banner Information . . . with the regular program” (Para. [0004] and [0036]).

With respect to the limitation pertaining to the usage of a “controller”, the Butler et al. reference comprises a “controller” [52] that “controls the presentation unit to display the Banner Information with the regular program”, however the reference is silent with respect to such being performed “upon permission only”. In an analogous art pertaining to interactive distribution systems, the Watts et al. reference discloses a method for distributing video programming and supplemental content including a “controller” [141] that “controls the presentation unit to display [the supplemental content] with the regular program upon permission only” (Watts et al.: Col 2, Line 63 – Col 4, Line 35; Col 5, Lines 28-33; Col 8, Lines 17-29; Col 9, Lines 31-38). Accordingly, it would have been obvious to one having

ordinary skill in the art at the time the invention was made so as to modify Butler et al. so as to further provide the ability for the user so as to enable/disable or to give “permission” to display received supplemental content or “Banner Information” for commonly known advantage of providing the user with improved flexibility with respect to the presentation of supplemental information. For example, such a means may advantageously provide the user with the ability to turn-off “Banner Information” or supplemental content should they desire not to be bothered by such pop-up information.

In consideration of claim 9, Figure 4 of the Butler et al. reference discloses a “method for providing digital television programming to viewers” comprising “creating a combined digital television signal which combines information reflective of regular programming” [220] and “information reflective of Banner Information” [226] which is subsequently “transmitted . . . over a channel” (Para. [0013] and [0050] – [0053]). The aforementioned “transmitted, combined digital signal” is subsequently “received” [230] at a “receiver” [14] (Figure 5) and are “provided to a presentation unit” [68] such that the “information reflective of the regular programming and the information reflective of the Banner Information are displayed simultaneously on the presentation unit” (Para. [0004] and [0036]).

With respect to the limitation pertaining to the usage of a “controller”, the Butler et al. reference comprises a “controller” [52] that “controls the presentation unit to display the Banner Information with the regular program”, however the reference is silent with respect to such being performed “upon permission only”. In an analogous art pertaining to interactive distribution systems, the Watts et al. reference discloses a method for distributing video programming and supplemental content including a “controller” [141] that “controls the

presentation unit to display [the supplemental content] with the regular program upon permission only” (Watts et al.: Col 2, Line 63 – Col 4, Line 35; Col 5, Lines 28-33; Col 8, Lines 17-29; Col 9, Lines 31-38). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Butler et al. so as to further provide the ability for the user so as to enable/disable or to give “permission” to display received supplemental content or “Banner Information” for commonly known advantage of providing the user with improved flexibility with respect to the presentation of supplemental information. For example, such a means may advantageously provide the user with the ability to turn-off “Banner Information” or supplemental content should they desire not to be bothered by such pop-up information.

Claim 12 is rejected wherein the user is “provided a receiver . . . which specifically enables the simultaneously display of the Banner Information and the regular programming on the presentation unit” in connection with the necessary hardware to receive and decode DBS signals (Para. [0002]). As aforementioned, in light of the combined references the “provided receiver” further “allows the controlling the presentation unit to display the Banner Information with the regular program only upon permission” (Watts et al.: Col 8, Lines 17-29; Col 9, Lines 31-38).

Claim 28 is rejected in light of the Watts et al. reference wherein the “permission” is implicitly “provided by a user who is a viewer of the regular program” (Watts et al.: Col 8, Lines 17-29) given that the user is equated with being a viewer of television programming.

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Claim 29 is rejected in wherein “if there is no permission the controller controls the presentation unit to display the regular program without the Banner Information” (Col 9, Lines 32-39).

6. Claims 2-8 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US Pub No. 2002/0007493 A1) in view of applicant’s admitted prior art (APA) relating to the MPEG-2 Standard.

In consideration of claim 2, the Butler et al. reference discloses that the “regular program and the Banner Information are synchronized” (Para. [0043]) as well as the particular usage of MPEG-2 in connection with the “providing” / distribution [12] of the combined digital signal (Para. [0015]). The reference, however, does not explicitly disclose details associated with the implementation of the standard including the creation of a “TS packetized” stream. Applicant’s admitted prior art discloses that the particular usage of TS packetization as defined in the MPEG-2 Standard is well known in the art (IA: Page 18, Lines 18-20). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to “create a TS packetized combined digital signal” in connection with complying with the MPEG-2 standard for the commonly known advantages associated with such including providing for consistent and uniform digital video signal sampling, coding, transmission and reception of programs along with audio and video overlays (IA: Page 2, Line 16 – Page 3, Line 8) in a manner that provides the robustness necessary for noisy channel distribution such as those employed by satellite distribution (Introduction – PART 1 Systems).



In consideration of claims 3 and 15, as aforementioned, the Butler et al. reference particularly discloses the usage of the MPEG-2 in connection with the distribution of a multiplexed digital signal. The reference, however, does not particularly disclose the details pertaining to the construction of a TS in accordance with the MPEG-2 standard (Para [0015]). Applicant's admitted prior art discloses that the MPEG-2 standard discloses details pertaining to the packetizing, multiplexing and sending of coded bit streams of multiple programs wherein multiple programs with audio and video overlays may be transmitted by a service provider and received by the end user (IA: Page 3, Lines 4-10). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to particularly utilize "a first coding unit for coding the regular program signal and a second coding unit for coding the Banner Information signal, a first TS packetization unit for receiving the coded regular program signal and providing a packetized bit stream reflecting the coded regular program signal and a second TS packetization unit for receiving the coded Banner Information signal and providing a packetized bit stream reflecting the coded Banner Information signal, a TS Packet multiplexer for receiving the packetized regular program signal and the packetized Banner Information signal and providing a multiplexed transport stream" for the purpose of providing a means so as to facilitate the encoding, packetizing, multiplexing, and providing of an MPEG-2 TS in accordance with the MPEG-2 standard and the associated inherent advantages associated with such including the ability to distribute multiple programs along with audio and video overlays with improved error resilience plus the ability to carry these programs simultaneously without requiring a common time base.

With respect to the particular limitation of a “channel modulation unit for modulating the transport stream into the combined digital signal and sending the combined digital signal for transmission to the channel”, the Butler et al. reference requires the particular usage of such given that the receiver utilizes a particular channel for the reception of the combined stream (Para. [0032]) and the source distributes the content over a particular channel (Para. [0013]). Further evidence is provided in light of co-pending application no. 08/503,055 (hereafter, Newell et al.) explicitly incorporated by reference which illustrates the particular usage of QPSK modulation [47] in association with the received signal (Figures 3 A/B).

In consideration of claims 4-7, 13, and 14, as aforementioned the Butler et al. reference discloses the particular usage of the MPEG-2 standard in connection with the processing of the received data wherein the particular utilization of a “TS packetized” streams in accordance with the standard would have been an obvious modification in order to provide the robustness necessary for noisy channels distribution channels such as those employed by satellite distribution. As illustrated in Figure 2, the “receiver” [14] further implicitly employs the claimed means for the purpose of demodulating, demultiplexing, depacketizing, decoding, and rendering an MPEG-2 packetized TS for the purpose of rendering the received MPEG-2 TS in accordance with the MPEG-2 standard. In particular, as further illustrated in Figures 3/A and 4 of the incorporated Newell et al. reference, the receiver comprises a “channel demodulation unit for demodulating the received combined digital signal and extracting bit streams of the regular program signal and the Banner Information signal from a user-tuned channel” [47], “a TS demultiplexing unit for demultiplexing the regular program bitstream and Banner Information TS packets from the signal received from the channel

demodulation unit” [45/45’], “a Banner Information TS depacketizer for receiving the Banner Information TS packets from the TS demultiplexing unit and depacketizing the Banner Information TS packets to provide a coded Banner Information signal” [45/45’], “a Rendering Unit for decoding and rendering the coded Banner Information into a bitmap video signal” [94], “a video reconstruction unit for receiving the rendered Information bitmap video signal and creating an output for the presentation device” [92], “Audio/video decoders for receiving the regular program bitstream from the TS demultiplexing unit . . . decoding audio and video coded bit streams of the regular program signal . . . [and] sending an Audio output signal for transducing into sound and a decoded video signal to the video reconstruction unit” [94/98], “the video reconstruction unit reconstructing an output video signal from the decoded video output and the rendered Banner Information bitmap video signal . . . [and] sending the video output signal . . . to the video presentation device” [46] for “display where the regular program and the Banner Information are displayed simultaneously” (Butler et al.: Para. [0032] – [0039]).

In consideration of claim 8, the claimed limitation do not set forth any over and above those addressed in the combined rejections of claims 1, 3, and 4 and is accordingly rejected as previously set forth. In particular, Figure 1 of Butler et al. illustrates a “digital video service network” [10] comprising a “means for providing” [12], a “receiver” [14], and a “channel for communicating the combined digital signal from the means for providing” (Para. [0013]). As aforementioned, while Butler et al. provides a “controller” [52] that “controls the video reconstruction unit to display the Banner Information with the regular program”, the reference is silent with respect to such being performed “upon permission

only”. In an analogous art pertaining to interactive distribution systems, the Watts et al. reference discloses a method for distributing a “combined digital signal having information reflective of a regular program signal and a Banner Information signal” including a “controller” [141] that “controls the video reconstruction unit to display the Banner Information with the regular program upon permission only” (Watts et al.: Col 2, Line 63 – Col 4, Line 35; Col 5, Lines 28-33; Col 8, Lines 17-29; Col 9, Lines 31-38). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Butler et al. so as to further provide the ability for the user so as to enable/disable or to give “permission” to display received supplemental content for commonly known advantage of providing the user with improved flexibility with respect to the presentation of supplemental information. For example, such a means may advantageously provide the user with the ability to turn-off “Banner Information” or supplemental content should they desire not to be bothered by such pop-up information.

7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US Pub No. 2002/0007493 A1) in view of applicant’s admission of fact (AAF).

In consideration of claims 10 and 11, the Butler et al. reference does not explicitly disclose the particular usage of “entering into an agreement with end-users which allows for” the aforementioned “simultaneous display of the Banner Information and the regular programming on the presentation unit” wherein “the agreement provides for a limitation on the subscription charged to the end user. Applicant’s admission of fact provides evidence as to the existence of service agreements (ex. quarterly/monthly/yearly subscriptions) that “allow” viewers to watch distributed programming and “provide for a limitation on the

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subscription charged to the end user" is notoriously well known in the art of video distribution (ex. IA: Page 3, Lines 14-17). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Butler et al. so as to employ the aforementioned service agreements for the inherent advantages associated with such including the ability of the service provider to profit or recoup costs associated with the distribution of video programming.

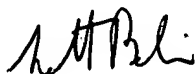
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Scott Beliveau  
Examiner

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